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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,960	04/06/2001	Don J. Chandler	112802-2701	6292

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EXAMINER

LE, HOA T

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,960

Applicant(s)

CHANDLER et al

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide a clear written description of the invention. The term “associated” or “associating” as used in the specification fails to denote the relation of the core particle and the magnetic substance. The term “desired magnetic response” as defined in the specification is confusing because the definition is circular. The “desired magnetic response” is basically defined as a “target magnetic response”. That does not explain or add anything to the term. The term “response” suggests a source and a medium. No such things are being recited in the definition.

Claim Rejections - 35 USC § 112

2. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the location/position of the substance in relation to the core particle is unclear. In addition, the phrase “associated with the particle” is unclear because it is unclear whether “the particle” is referred to the particle as a whole or just the core particle. In addition, it is unclear whether the “desired magnetic response” is the response desired for the substance or for the particle.

In claim 2, it's unclear what “polymeric magnetic” denotes. There is no substance that is known in the art as a “polymeric magnetic”. The specification fails to provide a clear definition of “polymeric magnetic”. Although at page 3, lines 23-25, an example of “polymeric magnetic material” is given, it is still not sufficiently clear as a definition such that the term can be acceptable as a claim language. It is suggested that the term “polymeric magnetic” be replaced with the exemplary language provided at page 3 or other equivalent description in order to obviate this rejection. Please note also that claim 1 upon which this claim depends recites “one substance” as “comprising magnetic material and polymeric material”.

Claim 4 is confusing. Claim 1 upon which it depends also recites a desired magnetic response. Thus, it is unclear whether the “desired” magnetic response in claim 4 is the same or different from that of claim 1.

Claim 6 is confusing because it is unclear whether the claim is directed to: (1) a particle and a core particle (note the location of commas) or (2) a particle comprising a magnetic substance and a core particle. In addition, claim 6 suffers the same deficiency of claim 1 as discussed above.

In claim 7, it is unclear whether the reactant is a component of the core particle or of the magnetic substance; and if neither, it is unclear about the location of the reactant in relation to the core and the magnetic substance.

In claim 15, it is unclear whether the non-magnetic nanospheres are part of the core particle or of the magnetic substance.

In claim 19, it is unclear whether the fluorescent tag is part of the core or of the magnetic substance; and if neither, it is unclear about the location of the tag in relation to the core and the magnetic substance.

Claim 20 is completely confusing. It is unclear what is being claimed. In addition, it is unclear what “pooled” denotes.

In claim 21, it is unclear what “associating” process is.

In claim 22, it is unclear whether “a core particle” is the same or different from the “particle” that the one magnetic substance was “associated” with.

In claim 25, "associating" as a process is unclear as discussed above. In addition, it is unclear how an "amount" can be "associated" with "particles".

In claim 27, it is unclear whether the "desired magnetic response" of each population is the response "desired" for that particular population or for the pooled set of the populations.

In claim 27, the term "associated" is unclear to define the relation between the core particles and the magnetic substance.

Other claims are deemed indefinite in view of their dependency upon either one of claims 1, 6, 21, 25 or 26.

3. The specification and the claims are confusing such that the examination of the application is being postponed until the specification and claims are amended for a better and clear understanding of the invention.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 703-308-2415. The examiner can normally be reached on 10:00 a.m. to 8:30 p.m., Mondays to Friday.

hl
August 26, 2002



H. T. Le
Primary Examiner
Art Unit 1773